REMARKS

Claims 1-10, 12-18 and 22-33 are presently pending in this application. Claims 11 and 19-21 have been cancelled, and claims 12, 13 and 15 have been amended in this response. More specifically, claim 13 has been rewritten in independent form, and claims 12 and 15 have been amended to depend from claim 13.

In the Final Office Action mailed August 11, 2005, claims 1-33 were rejected. More specifically, the status of the application in light of this Office Action is as follows:

(A) Claims 1-29 were rejected under 35 U.S.C. § 101;

(B) Claims 22, 23, 25 and 26 were rejected under 35 U.S.C. § 102(a) as being anticipated by "Polytechnic University, Notebook Computer Lease Agreement, Fall 2000" (the "Lease Agreement");

(C) Claims 32 and 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,013,897 to Harman et al. ("Harman");

(D) Claims 1-21, 24 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lease Agreement;

(E) Claims 30 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lease Agreement in view of Harman; and

(F) Claims 21 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lease Agreement in view of "Keeping a Roof Overhead" (the "Roof Overhead").

A. Response to the Section 101 Rejection

Claims 1-29 were rejected under 35 U.S.C. § 101. Specifically, the Examiner stated:

The basis of this rejection is set forth in a two prong test of:

> 1. Whether the invention is within the technological arts; and
>
> 2. Whether the invention produces a useful, concrete, and tangible result.
>
> For a claimed invention to be statutory, the claimed invention must be within the technological arts.

(Office Action, p. 2.)

The Board of Patent Appeals and Interferences has recently held that "there is no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101." (*Ex parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005)). Therefore, the Section 101 rejection of claims 1-29 is improper and should be withdrawn.

B. Response to the Section 102(a) Rejection Over the Lease Agreement

Claims 22, 23, 25 and 26 were rejected under 35 U.S.C. § 102(a) as being anticipated by the Lease Agreement. For the reasons described below, the Lease Agreement fails to disclose all the features of claim 22.

1. Claim 22 Is Directed to a Method for Obtaining Computer Equipment Including Voluntarily Returning the Computer Equipment to an Entity Without Penalty After an Arbitrary Period of Time Has Elapsed

Claim 22 is directed to a method for obtaining computer equipment including leasing the computer equipment from a leasing entity by receiving the computer equipment from the entity and paying to the entity at least one payment corresponding at least in part to a length of time the computer equipment is leased from the entity. The method further includes voluntarily returning the computer equipment to the entity without penalty after an arbitrary period of time has elapsed.

2. The Lease Agreement Requires a Student to Return the Notebook Computer to the University upon Premature Departure from the University

Students at Polytechnic University are required to lease a notebook computer from the University and sign the Lease Agreement. The Lease Agreement recites, "[f]ailure to enter into the notebook computer lease could have an adverse effect on your academic standing, as use of the notebook computer is essential to successful academic participation at the University." After a student graduates from the University and makes the final lease payment, the student has the option of purchasing the notebook computer from the University for One Dollar. If a student prematurely departs from the University, the student must immediately return the notebook computer to the Help Desk. Accordingly, a student cannot terminate the Lease Agreement and remain a student in good standing with the University.

3. The Lease Agreement Fails to Disclose Voluntarily Returning the Computer Equipment to the Entity Without Penalty After an Arbitrary Period of Time Has Elapsed

The Lease Agreement fails to disclose a method for obtaining computer equipment including, *inter alia*, "voluntarily returning the computer equipment to the entity without penalty after an arbitrary period of time has elapsed," as recited in claim 22. For example, assuming for the sake of argument that Polytechnic University in the Lease Agreement corresponds to the entity of claim 22, a student cannot voluntarily return the notebook computer to the University without penalty after an arbitrary period of time. Rather, a continuing student jeopardizes his or her academic standing by breaching the Lease Agreement and returning the notebook computer, and a student prematurely withdrawing from the University is required to immediately return the notebook computer to the University.

In the Final Office Action, the Examiner asserted:

> Applicant has argued that in the Polytechnic Lease agreement students are not allowed to voluntarily return a

> computer and end the lease. The examiner disagrees with the position taken by the applicant. If a student decides that they do not want to attend Polytechnic University anymore this is a voluntary decision. Applicant has stated that a student of the University cannot voluntarily return the leased computer without penalty. If a student wants to quit school, they return the computer (based on their voluntary decision to quit school) and leave school, with no penalty because this is what they wanted to do. This argument is non-persuasive as the prior art allows for one to voluntarily end the lease if they choose to do so contrary to what has been argued.

(Final Office Action, p. 15.)

The Examiner has conflated the student's two separate decisions: (a) enrollment at Polytechnic University; and (b) termination of the computer lease. Although a student at Polytechnic University may voluntarily withdraw from the University, the return of the computer equipment is not voluntary. Rather, the student "must immediately return the notebook computer to the Help Desk." Thus, the return of the notebook computer is not voluntary, but rather a contractual obligation. Alternatively, if a student voluntary returns the notebook computer to the University, then the student must withdraw from the University or the decision jeopardizes his or her academic standing at the University. Therefore, a student who voluntarily returns his or her notebook computer suffers a penalty. Accordingly, the Lease Agreement fails to disclose voluntarily returning computer equipment to an entity without penalty. Therefore, the Section 102(a) rejection of claim 22 should be withdrawn.

Claims 23, 25 and 26 depend from claim 22. Accordingly, the Section 102(a) rejection of claims 23, 25 and 26 should be withdrawn for the reasons discussed above with reference to claim 22 and for the additional features of these claims.

C. Response to the Section 102(b) Rejection Over Harman

Claims 32 and 33 were rejected under 35 U.S.C. § 102(b) as being anticipated by Harman. For the reasons described below, Harman fails to disclose all of the features of these claims.

1. Claim 32 Is Directed to a Computer System for Tracking Computer Leasing Information

Claim 32 is directed to a computer system for tracking computer leasing information including an identity tracker for tracking an identity of a piece of computer equipment and a lease payment tracker for tracking lease payments made by a customer leasing the piece of computer equipment. The system further includes a termination tracker for receiving an indication that the customer has terminated the lease of the computer equipment at a voluntary, arbitrary, customer-selected point in time without incurring a penalty to the customer for terminating the lease at the customer-selected point in time.

2. Harman Discloses a System for Renting Pre-Recorded Videocassettes

Harman discloses a system for renting pre-recorded videocassettes. The system includes an automatic videocassette dispensing terminal that communicates with, and becomes part of, a store's computerized videocassette rental system. The store's computer receives and stores information relating to customer rentals from both the automatic videocassette dispensing terminal and the manned point-of-sale terminal in the store. The automatic videocassette dispensing terminal projects through an exterior wall of the video store to provide 24-hour operation.

3. Harman Fails to Disclose a Computer System for Tracking Computer Leasing Information

Harman fails to disclose a computer system for tracking computer leasing information including, *inter alia*, "an identity tracker for tracking an identity of a piece of computer equipment," and "a termination tracker for receiving an indication that the

customer has terminated the lease of the computer equipment at a voluntary, arbitrary, customer-selected point in time without incurring a penalty to the customer for terminating the lease at the customer-selected point in time," as recited in claim 32. For example, Harman's computer system tracks videocassette rentals and not pieces of computer equipment. Moreover, even assuming for the sake of argument that one of Harman's videocassettes corresponds to the piece of computer equipment of claim 32, Harman's system does not include a component that corresponds to the termination tracker of claim 32. Specifically, no component in Harman's system receives an indication that a customer has terminated the rental of a videocassette at a voluntary, arbitrary, customer-selected point in time without incurring a penalty to the customer. Harman's customers cannot terminate the rental of a videocassette without incurring a penalty or having to pay for the full rental of the cassette.

In the Final Office Action, the Examiner asserted:

> The Harmon reference discloses a system for the tracking of rented items. The fact that applicant is tracking computer equipment as opposed to videocassettes does not matter, the claims are directed to the system for tracking, not the computer equipment. The intended use of the system is for tracking computer equipment and the intended use does not result in any structure being claimed that is not found in Harmon.

(Final Office Action, p. 15.)

The Examiner's assertion is improper and does not comply with the law. MPEP § 2173.05(g) recites:

> A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). . . . A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in

> association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

As a result, the Examiner must consider and give proper patentable weight to the functional limitations of claim 32. For example, the Examiner must give patentable weight to the "identity tracker for tracking an identity of a piece of computer equipment" claim limitation. As described above, Harman fails to disclose all the elements of claim 32. Therefore, the Section 102(b) rejection of claim 32 should be withdrawn.

Claim 33 depends from claim 32. Accordingly, the Section 102(b) rejection of claim 33 should be withdrawn for reasons discussed above with reference to claim 32 and for the additional features of this claim.

D. Response to the Section 103(a) Rejection Over the Lease Agreement

Claims 1-21, 24 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lease Agreement. For the reasons described below, the Lease Agreement fails to disclose or suggest the features of these claims.

Independent claim 1 has, *inter alia*, features generally similar to those included in claim 22. Accordingly, for the reasons described above with reference to claim 22, the Lease Agreement fails to disclose all the elements of claim 1. Moreover, one of ordinary skill in the art would not be motivated to modify the Lease Agreement to include the features of claim 1 because the Lease Agreement teaches away from such a modification. Specifically, the clear intent of the Lease Agreement is to require students to lease a notebook computer while enrolled with the University. The Lease Agreement notes that if a student fails to enter the Lease Agreement, it will adversely affect the student's academic standing because use of the notebook computer is essential to successful academic participation at the University. Therefore, the Lease Agreement teaches away from allowing the students to voluntarily terminate the Agreement after an arbitrary, student-selected time period has elapsed, without incurring a penalty to the student as required by claim 1. Accordingly, the Section

103(a) rejection of claim 1 should be withdrawn because (a) the Lease Agreement fails to disclose or suggest all of the features of claim 1, and (b) one skilled in the art would not be motivated to modify the Lease Agreement to include the features of claim 1.

Claims 2-10 depend from claim 1. Accordingly, the Section 103(a) rejection of claims 2-10 should be withdrawn for the reasons discussed above with reference to claim 1 and for the additional features of these claims.

Claims 11 and 19-21 have been cancelled in this response and therefore the rejection of these claims is now moot.

Claims 12, 14 and 15 depend from claim 13. Accordingly, the Section 103(a) rejection of claims 12, 14 and 15 should be withdrawn for the reasons discussed below with reference to claim 13 and for the additional features of these claims.

Independent claim 13 has, *inter alia*, features generally similar to those included in claim 1. Accordingly, the Section 103(a) rejection of claim 13 should be withdrawn for the reasons discussed above with reference to claim 1 and for the additional features of claim 13.

Independent claim 16 has, *inter alia*, features generally similar to those included in claim 1. Accordingly, the Section 103(a) rejection of claim 16 should be withdrawn for the reasons discussed above with reference to claim 1 and for the additional features of claim 16.

Claims 17 and 18 depend from claim 16. Accordingly, the Section 103(a) rejection of claims 17 and 18 should be withdrawn for the reasons discussed above with reference to claim 16 and for the additional features of these claims.

Claim 24 has, *inter alia*, features generally similar to those included in claim 1. Accordingly, the Section 103(a) rejection of claim 24 should be withdrawn for the

reasons discussed above with reference to claim 1 and for the additional features of claim 24.

1. Claim 27 Is Directed to a Method in a Computer System for Providing Computer Components to a Component Assembler Including Indicating Continued Periodic Payments from the Assembler After Having Received Total Payments from the Assembler for the Computer Component at Least Equal to the Initial Value of the Component

Claim 27 is directed to a method in a computer system for providing computer components to a component assembler including updating a database to indicate receiving from the assembler a commitment to lease at least a selected number of computer components and updating a database to indicate leasing each computer component to the assembler. The leasing includes providing the computer components to the assembler and receiving a plurality of periodic payments from the assembler. The method further includes indicating continued periodic payments from the assembler for at least one of the components after having received total payments from the assembler for the computer component at least equal to an initial value of at least one computer component.

2. The Lease Agreement Fails to Disclose or Suggest Indicating Continued Periodic Payments from the Assembler for at Least One of the Components After Having Received Payments at Least Equal to the Initial Value of the Component

The Lease Agreement fails to disclose or suggest a method in a computer system for providing computer components to a component assembler including, *inter alia*, "indicating continued periodic payments from the assembler for at least one of the components after having received total payments from the assembler for the computer component at least equal to an initial value of at least one computer component," as recited in claim 27. For example, assuming for the sake of argument that the student and the notebook computer of the Lease Agreement correspond to the assembler and the at least one component, respectively, of claim 27, the Lease Agreement does not disclose or suggest continued payments from the student for the notebook computer

after the University has received total payments from the student for the notebook computer equal to the initial value of the computer. As such, the Lease Agreement fails to disclose or suggest all the features of claim 27. Therefore, the Section 103(a) rejection of claim 27 should be withdrawn.

Claim 29 depends from claim 27. Accordingly, the Section 103(a) rejection of claim 29 should be withdrawn for the reasons discussed above with reference to claim 27 and for the additional features of claim 29.

E. Response to the Section 103(a) Rejection Over the Lease Agreement and Harman

Claims 30 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lease Agreement and Harman. Claim 30 has, *inter alia*, features generally similar to those included in claim 1. Accordingly, for the reasons described above with reference to claim 1, the Lease Agreement fails to disclose or suggest all the features of claim 30. Moreover, Harman fails to cure the above-noted deficiency of the Lease Agreement to properly support a *prima facie* case of obviousness with respect to claim 30. Specifically, Harman fails to provide a motivation for modifying the Lease Agreement to allow a student to terminate the lease of the notebook computer at a voluntary, arbitrary, student-selected point in time. Accordingly, the Section 103(a) rejection of claim 30 should be withdrawn.

Claim 31 depends from claim 30. Accordingly, the Section 103(a) rejection of claim 31 should be withdrawn for the reasons discussed above with reference to claim 30 and for the additional features of claim 31.

F. Response to the Section 103(a) Rejection Over the Lease Agreement and Roof Overhead

Claims 21 and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Lease Agreement in view of the Roof Overhead reference. Claim 21 has been cancelled and therefore the rejection of claim 21 is now moot.

Claim 28 depends from claim 27. Accordingly, for the reasons described above with reference to claim 27, the Lease Agreement fails to disclose or suggest all of the features of claim 28. The Roof Overhead reference fails to cure the above-noted deficiency of the Lease Agreement to properly support a *prima facie* case of obviousness under Section 103(a). Specifically, the Roof Overhead reference fails to provide a motivation to modify the Lease Agreement such that the student continues to pay periodic payments to the University for the notebook computer after the University receives payments at least equal to the initial value of the notebook computer. Accordingly, the Section 103(a) rejection of claim 28 should be withdrawn.

G. Conclusion

In light of the foregoing amendments and remarks, all of the pending claims are in condition for allowance. Applicant, therefore, requests reconsideration of the application and an allowance of all pending claims. If the Examiner wishes to discuss the above-noted distinctions between the claims and the cited references or any other distinctions, the Examiner is encouraged to contact David Dutcher by telephone. Additionally, if the Examiner notices any informalities in the claims, he is also encouraged to contact David Dutcher to expediently correct any such informalities.

Respectfully submitted,
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